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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/779,288	02/08/2001	George A. Huff JR.	37,248-03	6599

4249 7590 04/25/2003

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EXAMINER

MEDLEY, MARGARET B

ART UNIT	PAPER NUMBER
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1714

DATE MAILED: 04/25/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/779,288

Applicant(s)

HUFF ET AL.

Examiner

Margaret B. Medley

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 January 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) 15-22 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4,2.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

This action is in response to Paper No. 5 dated January 22, 2003 wherein applicants provisionally elected Group I directed to claims 1-14. Applicant did not abandon the invention directed to Group II directed to claims 15-22. The Group II claims 15-22 are withdrawn from consideration as being directed to the non-elected invention. The pending claims of record are claims 1-22.

The disclosure is objected to because of the following informalities: The "R" substitute on each of the formula appearing on pages 11 and 12 of the instant application should be corrected to read as R¹ to be consistent with the definition for R¹ appearing in line 1 after the formula on page 12 of the instant application. Applicant should determine if R or R¹ should be used.

Appropriate correction is required.

Claim 14 is objected to because of the following informalities: In line 1 after the formula, the R¹ definition is in conflict with the R substituent appearing in the claim. Applicant should determine if R or R¹ should be used and make the correction to concise with the correction required on pages 11 and 12 of the instant specification. Appropriate correction is required.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

Claims 11 and 14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The limitation in claim 11 that “at least 5 percent of the oxygen is contained in cyclic benzylic diketones” lacks support in claim 10 that require at least 10 percent of the oxygen. The said limitation of 5 percent is outside of the 10 percent requirement limitation of claim 10.

The limitation in claim 14 that the “aryl oxygenates are represented by the formula” appears to be a further limitation of claim 13 that require the aryl oxygenates to be of a different formula. It is suggested that applicant should insert the term “further” after the term “is” if the formula of claim 14 is in addition to claim 13 formula, but this combination of aryl oxygenates appears to be in conflict with the disclosure set forth on pages 10-12 of the instant application. Clarification is requested.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-3 and 5 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by EP 0,905,217 A (NIPPON OIL CO. LTD that teaches a composition for fuel or blending component of fuels comprising a liquid organic distillates having < 15 ppm sulfur and at least about 0.2 – about 20% oxygen as organic compounds, wherein the said organic oxygens added to the organic distillate is greater than 10⁰ C of the initial boiling point of the distillate, the fuel comprises additional fuel additives and the organic distillate is a mixture of organic compounds derived

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from natural petroleum, page 10, line 28 – page 10 line 39; tables 1 and 2, that anticipates the instant claims.

Claims 1 and 4 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Berlowitz et al (Berlowitz) 5,807,413 A that teaches a composition for fuel or blending component of fuels comprising a liquid organic distillates having < 15 ppm sulfur and at least about 0.2 – about 20% oxygen as organic compounds wherein the said organic distillates contain 5 to about 15 carbon atom of which at least about 85% are normal alkenes, column 1, line 26 to column 1, line 53, that anticipates the instant claims.

Claims 6-8 and 10-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Berlowitz 5,807,413 A as applied to claims 1 and 4 above, and further in view of Berlowitz 5,807,413 A in view of Taylor 47,923,963 and Davies et al (Davies) 6,010,545.

Applicants further teaches the fuel having flash points (FP) of at least 38⁰ C or 49⁰ C further additives of cold flow improvers and the oxygen being of cyclic benzylic ketones.

Berlowitz further teaches diesel fuel having FP of 140⁰ F and < 100⁰ F, Table 3 of column 4, that reads on the instant claimed FP of at least 38⁰ C or 49⁰ C.

Taylor teaches diesel fuel having oxygenated cyclic benzylic lactones, note column 6 at Table I for fluororenone and other lactone compounds providing the motivation for adding the cyclic benzylic ketones in Berlowitz fuels with the reasonable expectation that the additive will impart its oxygenate properties in the fuel that render the instant claims obvious.

Davis teaches and discloses diesel fuel comprising flow improvers, column 6, lines 33 to column 10, lines 58, especially column 8, lines 20-47 providing the motivation for adding the

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additive to the fuel of Berlowitz with the reasonable expectation of imparting it flow properties to the fuel that render the instant claims obvious.

Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over EP 905 217 A Nippon Oil Co. Ltd. as applied to claims 1-3 and 5 above, and further in view of EP 905 217 A Nippon Oil Co. Ltd.

Applicant further claims Reid vapor pressure (RVP) of at least 6 psi.

EP '217 further teaches that the RVP should be less than 55 kPa to preclude the possibility of gasoline coking in the injector and to suppress the amount of evaporative emission, page 7 section [0050] that suggest the RVP of 6 psi that render the instant claims obvious.

The prior art made of record and not relied upon further teaches fuel and fuel components of the same nature as claimed by applicants.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Margaret B. Medley whose telephone number is (703) 308-2518. The examiner can normally be reached on Monday--Friday from 7:30 a.m. to 6:30 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on (703) 306-2777. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

M.B. Medley/dh
April 24, 2003

Margaret B. Medley
MARGARET MEDLEY
PRIMARY EXAMINER